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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,233	01/20/2004	Yoshiumi Hamada	46238	6456

1609 7590 11/24/2006

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EXAMINER

BRUENJES, CHRISTOPHER P

ART UNIT PAPER NUMBER

1772

DATE MAILED: 11/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/759,233

Applicant(s)

HAMADA, YOSHIUMI

Examiner

Christopher P. Bruenjes

Art Unit

1772

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 November 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): see continuation sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: none.
Claim(s) objected to: none.
Claim(s) rejected: 1-4,6-11,22,24 and 26.
Claim(s) withdrawn from consideration: 13-21.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____

Art Unit: 1772

ADVISORY ACTION

Acknowledgment of Applicant's Amendment

1. Applicant's amendment filed November 6, 2006 has been entered for purposes of appeal.

WITHDRAWN REJECTIONS

2. On appeal, the 35 U.S.C. 103 rejections of claims 1-4, 6, 7, and 22 over Oberthur et al in view of Wysocki of record in the Office Action mailed July 6, 2006, Pages 3-6 Paragraph 7, will be withdrawn due to Applicant's amendments in the Paper filed November 6, 2006.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for

Art Unit: 1772

establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1-4, 6-11, 22, 24, and 26 are rejected under 35

U.S.C. 103(a) as being unpatentable over Oberthur et al (USPN 6,369,042) in view of Wysocki (USPN 4,261,462) and Canter et al (USPN 6,060,547).

Regarding claims 1 and 22, Oberthur et al teach a composition, which comprises a coloring agent (col.15, 1.65 - col.16, 1.1), a cosmetic (col.16, 1.11-29), an organic solvent, and water (col.16, 1.3-10), used for skin or body paint (col.10, 1.3-12 and 61-66). Furthermore, the composition is formed as an aerosol and placed in a container such as a can to be sprayed on to the skin by utilizing a propellant in the composition (col.16, 1.30-41).

Oberthur et al fail to teach that the container housing the composition further includes an illustrative medium made up of descriptive text and/or images. However, Wysocki teach providing illustrative mediums in the form of labels directly to a container for cosmetic preparations and also directly printed

Art Unit: 1772

on outer packaging of bottles containing cosmetic preparations in order to provide information and directions on use of the contained cosmetic. In particular, the direct printing on the outer package teaches the limitations of **claim 2**, and the label teaches the limitations of **claims 3-4**. Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made that the two references are analogous insofar as both references are concerned the packaging of cosmetics, and that illustrative text and/or images are applied to containers for cosmetics as well as outer packaging for the same, in order to provide the user of the cosmetic with information and directions, as taught by Wysocki.

Thus, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to add illustrative text and/or images as taught by Wysocki to the cosmetic container of Oberthur et al in the form of a label and/or outer packaging in order to provide the user of the cosmetic with information and directions, as taught by Wysocki.

Note that the limitation that the illustrative medium "informs users that a stocking-like layer is formed by directly spray-jetting the above coloring agent along with the cosmetic on stocking-less legs" is a limitation directed at non-functional printed matter. Nonfunctional printed matter does

Art Unit: 1772

not distinguish a claimed product from an otherwise identical prior art product because where the printed matter is not functionally related to the substrate; the printed matter will not distinguish the invention from the prior art in terms of patentability. The critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. See MPEP 2112.01 III. In this case, Wysocki teach illustrative text and/or images on the container and outer package even though the content of the text and/or images may be different from the claimed invention.

Oberthur et al and Wysocki fail to explicitly teach that the cosmetic composition includes a film forming polymer. However, Canter et al teach that film forming polymers are added to skin cosmetics in order to provide better looking, longer lasting benefits compared to conventional skin cosmetics (col.2, 1.42-47). Canter et al teach that film forming polymers are added to a cosmetic composition in the amount between 0.5% and 10% in order to provide superior feel, look and wear characteristics to the cosmetic composition (col.4, 1.1-10). Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to add a film forming polymer in an amount between 0.5% and 10% to a cosmetic composition in order to provide the composition with

Art Unit: 1772

enhanced feel, look, and wear characteristics, as taught by Canter et al.

Thus, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to add a film forming polymer in an amount between 0.5% and 10% to the cosmetic composition of Oberthur et al in order to provide the cosmetic composition with enhanced feel, look, and wear characteristics, as taught by Canter et al.

Regarding claims 6-7, Oberthur et al teach the coloring agent is an organic pigment (col.4, 1.19-25) and is included in an amount of 0.15% by weight based on the weight of the composition (col.10, 1.29-33 and col.16, 1.1-2).

Regarding claims 8-11 and 24 and 26, Oberthur et al teach that the coloring agent formed of the analog has its color influenced by the addition of other pigments, but Oberthur et al and Wysocki fail to teach what the other pigments are that are added to the cosmetic composition. However, Canter et al teach coloring agents well known in the art of cosmetic compositions include pearling agents, which form pearly lusters, titanium oxide, silk powder, zinc oxide, iron oxide, ultramarine, mica, and silica (col.8, 1.25-39). Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to select pigments to influence

Art Unit: 1772

color in a cosmetic composition from known pigments used for that purpose.

Thus, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to select the coloring agent pigment added to the cosmetic composition of Oberthur et al in order to influence the color from the known pigments described in Canter et al, since Canter et al teach that those particular pigments are known in the art and one of ordinary skill in the art would obviously select additional pigments from known pigments for that purpose.

ANSWERS TO APPLICANT'S ARGUMENTS

6. Applicant's arguments regarding the 35 U.S.C. 103 rejections of claims 1-4, 6, 7, and 22 over Oberthur et al in view of Wysocki are moot since the rejections will be withdrawn upon appeal.

7. Applicant's arguments regarding the 35 U.S.C. 103 rejections of claims 8-12 and 24-26 over Oberthur et al in view of Wysocki and Canter have been fully considered but are not found persuasive.

In response to applicant's argument that the three references in combination fail to teach the sprayable

Art Unit: 1772

composition claimed, all of the elements claimed for the composition are taught in the combination of references as shown in the rejection above.

In response to Applicant's argument that the combination references fails to teach an illustrative medium to assist the user in applying the composition to the legs to form the appearance of stockings, what the illustrative medium says is not germane to the patentability of an article. Nonfunctional printed matter does not distinguish a claimed product from an otherwise identical prior art product because where the printed matter is not functionally related to the substrate; the printed matter will not distinguish the invention from the prior art in terms of patentability. The critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. See MPEP 2112.01 III. In this case, Wysocki teach illustrative text and/or images on the container and outer package even though the content of the text and/or images may be different from the claimed invention.

In response to Applicant's argument that Oberthur et al fails to suggest that the composition is capable of simulating stockings applied to the legs, Oberthur et al specifically teaches that the composition is used for skin paint and/or body paint. Furthermore, the combination of Oberthur et al and

Art Unit: 1772

Canter et al teaches a composition that is the same as the claimed composition and compositions must have the same properties. Therefore, if the composition taught by the combination of Oberthur and Canter is the same as the claimed composition then it must be capable of simulating stockings on the legs of a person. Finding a new use for a known article does not render the known article patentable.

In response to Applicant's argument that Oberthur et al and Canter et al fail to suggest adding the film forming polymer to Oberthur et al to enhance transfer resistance and abrasion resistance, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In this case, Canter et al provides a different motivation for adding the film forming polymer to the composition of Oberthur et al.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P.

Art Unit: 1772

Bruenjes whose telephone number is 571-272-1489. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher P Bruenjes
Examiner
Art Unit 1772

CPB

November 21, 2006


ALICIA CHEVALIER
PRIMARY EXAMINER